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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/777,701

02/12/2004

J. Richard Braun

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05/18/2006

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EXAMINER

NGUYEN, SON T

ART UNIT

PAPER NUMBER

3643

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/777,701	BRAUN, J. RICHARD	
	<b>Examiner</b>	<b>Art Unit</b>	
	Son T. Nguyen	3643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-12, 16-28 and 32-41 is/are pending in the application.
- 4a) Of the above claim(s) 7-10, 23-26 and 34-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 11, 12, 16-22, 27, 28, 32, 33, 40 and 41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

SON T. NGUYEN  
PRIMARY EXAMINER

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 1, 3 & 4** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites the subcombination of a planter receptacle; however, claims 3-4 recite the combination of a planter receptacle and at least one vertical support member of a railing (note, claim 3 positively recites that the stabilizing means at least partially surrounds said at least one vertical support member of said railing, and claim 4 positively recites that the walls at least partially surround said at least one vertical support member of said railing). Therefore, the scope of the claims is inconsistent, and thus, the claims should be amended to consistently recite the combination or the subcombination.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-6,11,12,16,40** are rejected under 35 U.S.C. 103(a) as being unpatentable over DuMars et al. (5741339) in view of Reed (6655083).

For claim 1, DuMars et al. teach a planter receptacle comprising a front wall 60; a back wall 62; first and second spaced-apart side walls 56,58, wherein the front wall is connected to the first and second side walls, and the back wall is connected to the first and second side walls, forming an enclosure with the front wall, back wall, and first and second side walls (see fig. 6); and stabilizing means 57,59 for providing horizontal stability, wherein the receptacle is adapted to be suspended by a hanging means from a railing comprising at least one vertical support member (note, the receptacle of DuMars is adapted to be suspended if one wishes to do so since the language of “adapted” is functional). However, DuMars et al. are silent about hanging means such as chain that can be attached to the at least one non-vertical support member and the stabilizing means can remain detached from the at least one vertical support member.

Reed teaches the same field of endeavor of a planter 10 in which Reed suspends his planter by using chain 19 to a support structure. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ chain as taught by Reed to suspend the planter receptacle of DuMars et al. in order to elevate the planter receptacle for decoration purposes and to also further secure the planter receptacle to a structure by using the chain. Note, once the chain is employed in DuMars, the functional limitation of “whereby said hanging means can be attached...”.

For claim 2, DuMars et al. as modified by Reed (emphasis on DuMars et al.) further teach a bottom wall 54, wherein the bottom wall forms at least a portion of the

underside of the enclosure formed by the front wall, the back wall, and the first and second side walls (see fig. 7 of DuMars).

For claim 3, DuMars et al. as modified by Reed (emphasis on DuMars et al.) further teach the stabilizing means at least partially surrounds the at least one vertical support member (see col. 5, 30-35 of DuMars, which they teach that the holes 57,59 are to be provided with reinforcing bar, which is considered to be a vertical member, and the holes are intended for some sort of vertical support member to fit therethrough). Note also the 112 rejection above.

For claim 4, DuMars et al. as modified by Reed (emphasis on DuMars et al.) further teach the stabilizing means comprises at least one interior wall (figs. 6 & 8, the wall where line 5-5 is drawn through) connected to the first and second side walls between the front and back walls, creating a first enclosure formed by the front wall, the at least one interior wall, and a portion of the first and second side walls (see figs. 6 & 8), and a second enclosure formed by the at least one interior wall, the back wall, and a portion of the first and second side walls, wherein the at least one interior wall, the back wall, and the portion of the first and second side walls at least partially surround the at least one vertical support member of the railing when the planter receptacle is suspended from the railing (see col. 5, lines 30-35 of DuMars, which they teach that the holes 57,59 are to be provided with reinforcing bar, which is considered to be a vertical member). Note also the 112 rejection above and the optional language of "when".

For claim 5, DuMars et al. as modified by Reed (emphasis on DuMars et al.) further teach wherein the at least one interior wall is substantially parallel to the back wall (see fig. 6).

For claim 6, DuMars et al. as modified by Reed (emphasis on DuMars et al.) further teach a bottom wall 71, wherein the bottom wall forms at least a portion of the underside of the first enclosure formed by the front wall, and the at least one interior wall, and a portion of the first and second side walls (see figs. 6-8).

For claim 11, DuMars et al. lack connecting means. In addition to the above, Reed further teaches a connecting means 17 attached to one of the walls of his planter to enables engagement with the chain 19. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ connecting means as further taught by Reed attached to one of the walls of the receptacle of DuMars et al. as modified by Reed in order to provide a connection point between the chain and the receptacle so as to hang or further support the receptacle.

For claim 12, since the connecting means of Reed is like a screw, one can unscrew it to not go all the way in the receptacle, thus, making it vertically adjustable with respect to the walls of the receptacle by screwing it up and down. Therefore, DuMars et al. as modified by Reed teaches the connecting means is vertically adjustable.

For claim 16, the hanging means of DuMars et al. as modified by Reed can functionally enables the receptacle to be positioned at various height if one wishes to do so. Note the functional recitation of "enables...to be positioned".

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5. **Claims 17-22,27,28,32,33,40,41** are rejected under 35 U.S.C. 103(a) as being unpatentable over DuMars et al. (as above) in view of Reed (as above) and Tilton (6796539).

For claims 17 & 32, as explained above, DuMars et al. teach the planter receptacle and Reed teaches the hanging means. However, DuMars et al. lack the feature of the railing comprising a top rail and vertical support member. Tilton teaches the same field of endeavor of a planter and a railing assembly, the assembly comprising a top rail/rail cap 37 and vertical support members 11,12. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the railing with a top rail and vertical support members as taught by Tilton to support the planter receptacle of DuMars et al. as modified by Reed in order to provide a support for the receptacle and to mount on the railing for decorative purpose. Note, since DuMars already teaches that some sort of supporting member is to go through the holes 57,59, by putting the vertical support member of Tilton does not change the function of the planter receptacle of DuMars since DuMars states to further support the weight of the planter receptacle (col. 5, lines 30-35 of DuMars). In addition, it would have been obvious to one having ordinary skill in the art at the time the invention was made to connect the hanging means of DuMars et al. as modified by Reed and Tilton to the rail cap, depending on where the strongest point on the railing to support maximum load.

For claim 18, see claim 2 above.

For claim 19, see claim 3 above.

For claim 20, see claim 4 above.

For claim 21, see claim 5 above.

For claim 22, see claim 6 above.

For claim 27, see claim 11 above.

For claims 28,40 & 41, see claim 12 above.

For claim 33, see claim 16 above.

For claim 40, see claim 16 above.

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1-6,11,12,16-22,27,28,32-33,40,41 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.




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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son T. Nguyen whose telephone number is 571-272-6889. The examiner can normally be reached on Mon-Thu from 10:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on 571-272-6891. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Son T. Nguyen  
Primary Examiner  
Art Unit 3643

stn